



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,738	04/05/2001	Steven Thomas Winkler	7781.0209-00	6058

22852 7590 11/03/2005

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

BAUM, RONALD

ART UNIT PAPER NUMBER

2136

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,738

Applicant(s)

WINKLER ET AL.

Examiner

Ronald Baum

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in reply to applicant's correspondence of 19 August 2005.
2. Claims 1-22 are pending for examination.
3. Claims 1-22 remain rejected.

Claim Objections

4. The claim 14 objection is withdrawn.

Claim Rejections - 35 USC § 112

5. The claims 6, 20 and 22 rejections are withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Greco et al, U.S.

Patent No. US 2002/0120680 A1.

Art Unit: 2136

7. As per claim 1; “A method of setting up a generic security service, said generic security service being capable of calling an electronic signing service from among a plurality of electronic signing services, comprising:

indicating which types of documents require a signature [paragraphs 0032, 0047, 0059-0063, 0075];

for each type of said documents requiring a signature,

indicating if a signature is required for a full document;

for each type of said documents requiring a signature,

but not requiring a signature for a full document,

indicating which data elements within a respective document require a signature [paragraphs 0006, 0030-0033, 0042, 0047, 0059-0063, 0075, 0098, 0101, page 9, claims 19, 38, 39].”.

And further as per claim 16; “A generic security service tool [This claim is an apparatus claim for limitations from the method claim 1 above, and is rejected for the same reasons provided for the claim 1 rejection] comprising:

generic signature software, said generic signature software permitting

a tool user to set up a signature framework for various document types

[paragraphs 0032, 0047, 0059-0063, 0075];

signature memory, said signature memory

storing said signature framework for various document types [paragraphs

0032, 0047, 0059-0063, 0075, 0098, 0101, page 9, claims 19, 38, 39];

wherein said generic signature software

presents said tool user with

a list of document types that could require a signature, and

permits said tool user to

input which of said document types require said signature [paragraphs 0006, 0030-0033, 0042, 0047, 0059-0063, 0075, 0094, 0098, 0101, page 9, claims 19,38,39].”.

And further as per claim 17; “A generic security service tool [This claim is an apparatus claim for limitations from the method claim 1 above, and is rejected for the same reasons provided for the claim 1 rejection] as in claim 16, wherein said generic signature software further

permits said tool user to select if said signature is required for

a full document or

selected data elements for each of said document types, and

to select said data elements or to indicate that said selected data elements will be determined by an intended recipient [paragraphs 0006, 0030-0033, 0042, 0047, 0059-0063, 0075, 0094, 0098, 0101, page 9, claims 19,38,39].”.

8. Claim 2 *additionally recites* the limitations that; “A method as in claim 1, further comprising the step of:

creating a layout of a representation of said data elements requiring signature. ”.

The teachings of Greco et al (paragraphs 0059-0063, 0094) suggest such limitations.

Claim 18 *additionally recites* the limitations that; “A generic security service tool [This claim is an apparatus claim for limitations from the method claim 2 above, and is rejected for the same reasons provided for the claim 2 rejection] as in claim 17, wherein said generic signature software further

permits said tool user to set up a layout of a representation of said selected data elements.”.

The teachings of Greco et al (paragraphs 0059-0063,0094) suggest such limitations.

9. Claim 3 *additionally recites* the limitations that; “A method as in claim 2, wherein said creating step comprises

adding text to said layout.”.

The teachings of Greco et al (paragraphs 0006,0007,0059-0063,0094) suggest such limitations.

Claim 19 *additionally recites* the limitations that; “A generic security service tool [This claim is an apparatus claim for limitations from the method claim 3 above, and is rejected for the same reasons provided for the claim 3 rejection] as in claim 18, wherein

said tool user can add text to said layout. ”.

The teachings of Greco et al (paragraphs 0006,0007,0059-0063,0094) suggest such limitations.

10. Claim 4 *additionally recites* the limitations that; “A method as in claim 2, further comprising the step of:

Art Unit: 2136

saving said layout in a database.”.

The teachings of Greco et al (paragraphs 0006,0007,0059-0063,0066,0083,0084,0094) suggest such limitations.

Claim 20 *additionally recites* the limitations that; “A generic security service tool [This claim is an apparatus claim for limitations from the method claim 4 above, and is rejected for the same reasons provided for the claim 4 rejection] as in claim 18, wherein

said layout can be stored in said signature memory ”.

The teachings of Greco et al (paragraphs 0006,0007,0059-0063,0066,0083,0084,0094) suggest such limitations.

11. Claim 5 *additionally recites* the limitations that; “A method as in claim 1, further comprising the step of:

indicating which of said plurality of electronic signing services is to be called.”.

The teachings of Greco et al (paragraphs 0006,0030-0033,0042,0047,0059-0063,0075,0098,0101, page 9,claims 19,38,39) suggest such limitations.

Claim 21 *additionally recites* the limitations that; “A generic security service tool [This claim is an apparatus claim for limitations from the method claim 5 above, and is rejected for the same reasons provided for the claim 5 rejection] as in claim 17, wherein

Art Unit: 2136

said generic signature software permits said tool user to indicate which electronic signature technology is to be utilized from among a plurality of electronic signature technologies.”.

The teachings of Greco et al (paragraphs 0006,0030-0033,0042,0047,0059-0063,0075,0098,0101, page 9,claims 19,38,39) suggest such limitations.

12. Claim 6 ***additionally recites*** the limitations that; “A method as in claim 5, wherein said indicating step comprises

selecting said electronic signing service to be called from a list of said plurality of electronic signing services.”.

The teachings of Greco et al suggest (paragraphs 0006,0030-0033,0042,0047,0059-0063,0075,0098,0101, page 9,claims 19,38,39) such limitations.

Claim 22 ***additionally recites*** the limitations that; “A generic security service tool [This claim is an apparatus claim for limitations from the method claim 6 above, and is rejected for the same reasons provided for the claim 6 rejection] as in claim 21, wherein

said generic signature software permits said tool user to indicate said electronic signature technology to be utilized by presenting said tool user a list of said plurality of electronic signature technologies from which said tool user may select.”.

The teachings of Greco et al (paragraphs 0006,0030-0033,0042,0047,0059-0063,0075,0098,0101, page 9,claims 19,38,39) suggest such limitations.

Art Unit: 2136

13. As per claim 7; “A method of facilitating electronic signature of a document residing on a computer accessible through a network by a user at a remote location comprising the steps of:

providing said user with

a representation of a document for signature through a browser;

permitting said user to indicate to said computer that

said document should be signed; and,

if said user indicates that said document should be signed,

saving said signature on said computer as

a parameter separate from said document;

providing

said signature and

said document to another service [paragraphs 0032,0047,0059-

0063,0066,0072,0073,0075,0076,0086-0090,page 10,claims 41-48].”.

14. Claim 8 *additionally recites* the limitations that; “A method of facilitating electronic signature as in claim 7, wherein said indication to sign said document comprises

said user clicking a button on said browser. ”.

The teachings of Greco et al (paragraphs 0032,0047,0059-

0063,0066,0072,0073,0075,0076,0086-0090,0092,0094,page 10,claims 41-48) suggest such limitations.

Art Unit: 2136

15. Claim 9 *additionally recites* the limitations that; “A method of facilitating electronic signature as in claim 7, wherein said representation comprises
an entirety of said document.”.

The teachings of Greco et al (paragraphs 0032,0047,0059-0063,0066,0072,0073,0075,0076, 0086-0090,0092,0094,page 10,claims 41-48) suggest such limitations.

16. Claim 10 *additionally recites* the limitations that; “A method of facilitating electronic signature as in claim 7, wherein said representation comprises
a set of selected data elements of said document. ”.

The teachings of Greco et al (paragraphs 0032,0047,0059-0063,0066,0072,0073,0075,0076, 0086-0090,0092,0094,page 10,claims 41-48) suggest such limitations.

17. Claim 11 *additionally recites* the limitations that; “A method of facilitating electronic signature as in claim 10, wherein said representation further comprises
text.”.

The teachings of Greco et al (paragraphs 0006,0007,0059-0063,0094) suggest such limitations.

18. Claim 12 *additionally recites* the limitations that; “A method of facilitating electronic signature as in claim 7, wherein said providing said user step further comprises
displaying to said user either
said entire document itself or

a representation of said document that comprises selected data elements of said document based upon a view selection by said user.”.

The teachings of Greco et al (paragraphs 0032,0047,0059-0063,0066,0072,0073,0075,0076,0086-0090,0092,0094,page 10,claims 41-48) suggest such limitations.

19. Claim 13 *additionally recites* the limitations that; “A method of facilitating electronic signature as in claim 7, wherein said computer is an electronic marketplace.”.

The teachings of Greco et al (paragraphs 0002-0011,0032,0047,0059-0063,0066,0072,0073,0075,0076,0086-0090,0092,0094,page 10,claims 41-48; such that the Greco et al Internet environment is clearly and inherently an electronic marketplace) suggest such limitations.

20. Claim 14 *additionally recites* the limitations that; “A method of facilitating electronic signature as in claim 7, wherein said network is an Internet.”.

The teachings of Greco et al (paragraphs 0002-0011,0032,0047,0059-0063,0066,0072,0073,0075,0076,0086-0090,0092,0094,page 10,claims 41-48; such that the Greco et al Internet environment is clearly and inherently an electronic marketplace) suggest such limitations.

Art Unit: 2136

21. Claim 15 ***additionally recites*** the limitations that; “A method of facilitating electronic signature as in claim 7, further comprising the steps of:

determining if an intended recipient is responsible for providing said representation of said document for signature;

if said intended recipient is responsible,

sending said document to said intended recipient and

receiving said electronic representation from said intended recipient. ”.

The teachings of Greco et al (paragraphs 0013,0032-0040,0047-0048,0052-00550059-0063,0065,0066,0069-0073,0075,0076,0086-0092,page 10,claims 41-48) suggest such limitations.

Transitional provisional application reference

¶ 7.82.02 Copy of Provisional Application(s) Relied Upon for Prior Art Effect May Not be Supplied

If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a

Art Unit: 2136

substantial delay by the Office in fulfilling the order for the copy of the provisional application.

Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge will not apply.

Response to Amendment

22. As per applicant's argument concerning the lack of teaching by Greco et al of the "... indicating which type of documents require a signature...", the examiner has fully considered in this response to amendment; the arguments, and finds them not to be persuasive. The examiner interprets the applicant's use of the phrase "indicating ... types of documents" in the broader sense in that the claim language fails to deal with the document "type" specificity. Nowhere in the claim language does the recitation of a requirement for an explicit claiming of the differentiation aspect concerning the various types of document components (i.e., Microsoft WORD documents include macro scripts, of which while the links to said macros are part of the documents, the specification of documents with said macros would not necessarily include the macros; thus they are selected/deselected from signing). Also, WORD templates, and other WORD inherent document components would not necessarily be included unless explicitly specified in such signature/security authentication scenarios at the time of (i.e., via the user interface to the functional processing through the Windows GUI, toolbar, etc.). Therefore, at a "document ... type" level that would encompass delineation by document file name/extension/template/macro, the various Greco et al WORD component delineations, as being *broadly interpreted by the examiner*, as per the claim language, would therefore be

Art Unit: 2136

applicable in the rejection, such that the rejection support reference collectively encompass the said claim limitations in their entirety.

23. As per applicant's argument concerning the lack of teaching by Greco et al of the "... indicating which elements of documents require a signature...", the examiner has fully considered in this response to amendment; the arguments, and finds them not to be persuasive for at least the same analogous reasons as described above for the "type" aspect (versus the "component" specificity aspect).

24. As per applicant's argument concerning the lack of teaching by Greco et al of the missing recitation of Greco et al reference for "... for each type ... full document ...", the examiner has fully considered in this response to amendment; the arguments, and finds them not to be persuasive for at least the same analogous reasons as described above for the "type" and "components" aspects above, in that the element rejection covers the said missing element as part of the same rejection.

25. As per applicant's argument concerning the lack of teaching by Greco et al of the "... permit a tool user to setup a signature framework ... types ...", the examiner has fully considered in this response to amendment; the arguments, and finds them not to be persuasive for at least the same analogous reasons as described above for the "type" and "components" aspects above, in that the reference clearly inherently applies at the framework/apparatus level of embodiment.

Art Unit: 2136

26. As per applicant's argument concerning the lack of teaching by Greco et al of the "... permitting, indicating, saving and providing..." aspects of signature related functionality, the examiner has fully considered in this response to amendment; the arguments, and finds them not to be persuasive in that the reference clearly inherently applies at the framework/apparatus level of embodiment, of which said "... permitting, indicating, saving and providing..." would also clearly inherently apply (i.e., the document, signature aspects, etc., are "indicated" via user GUI, the data elements on the processing platform; PC or whatever, is clearly stored/saved at various levels, etc.).

27. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 2136

Conclusion

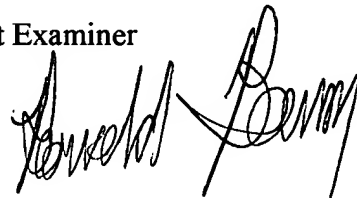
28. Any inquiry concerning this communication or earlier communications from examiner should be directed to Ronald Baum, whose telephone number is (571) 272-3861, and whose unofficial Fax number is (571) 273-3861. The examiner can normally be reached Monday through Thursday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh, can be reached at (571) 272-3795. The Fax number for the organization where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. For more information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ronald Baum

Patent Examiner



AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100